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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,086	03/26/2001	Jean-Michel Simon	FR 000029	9827
24737	7590	10/22/2004	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			PHU, SANH D	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,086

Applicant(s)

SIMON, JEAN-MICHEL

Examiner

Sanh D Phu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 7/23/04.

Specification

2. The Specification and Abstract of amendment, which was filed on 4/1/04, is objected under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- “an apparatus that avoids the necessity of using a computer for **updating operation software within a storage device**”; and
- “while the embodiments of the present invention disclosed herein are presently considered to be preferred, **various changes and modifications can be made without departing from the spirit and scope of the invention. The scope of the invention is indicated in the appended claims, and all changes that come within the meaning and range of equivalents are intended to be embraced therein**”.

- In Abstract "The operation of the apparatus (1) depends on operation software contained in a storage device (45). It often appears to be necessary to **update the stored operation software**. For this purpose, **update data** contained in another storage device of another apparatus (50), of the same type as the apparatus (1), is **tapped by the apparatus (1) for storage within storage device (45)**. This updating technique for the stored operation software has an application to portable cellular telephony apparatus."

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections – 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5, 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains

subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitations “a storage device for **storing operation software**” and “updating means for **updating the operation software stored within said storage device** via an interfacing with another apparatus of the same type”. These limitations are considered new matter because the specification, as originally filed, does not support for such limitations.

Claim 5 recites the limitations “**storing operation software in a first apparatus**” and “tapping update data from a second apparatus of the same type as the first apparatus to **update the operation software in the first apparatus**”. These limitations are considered new matter because the specification, as originally filed, does not support for such limitations.

Claim 7 recites the limitation “means for exchanging update data for **updating operation software stored within a first apparatus** wherein a second apparatus communicates the update data to the first apparatus and **the operation software stored within the first apparatus is updated with the update**

data". This limitation is considered new matter because the specification, as originally filed, does not support for such limitation.

Claims, (if any) depended on above claims, are therefore, also rejected. The below rejections are assuming that the limitations of the amendment are not new matter.

Claim Rejections – 35 USC 103

5. The following rejections are assuming that the limitations of the amendment are not new matter.

Claim Rejections – 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1,2, 5-7 are rejected under 35 U.S.C 103(a) as being unpatentable over Yasuda et al (5,062,132) in view of Ellis et al (6,771,317).

Regarding to claim 1, (see Fig. 1,2 & 3 and col. 2, line 49 to col. 5 line 38) Yasuda et al disclose an apparatus (1B) wherein the apparatus comprises a storage device (9) for storing data, and updating means (8,11A, 11B, 21) for updating within said storage device from another apparatus (1A) of the same type (see Fig. 3 and col. 3, line 58 to col. 4 line 7).

He does not disclose that the data, which is stored in RAM, is operating software.

However, Ellis et al disclose that the application software is stored in non-volatile memory such as ROM or static RAM (see col. 9, lines 16-21).

Therefore, at the time of the invention was made, it would have been obvious for one having skilled in the art to modify the data to the operating software, as taught by Ellis et al, so that the apparatus is capable to operate a new software.

Regarding to claim 2 (see fig. 2), Yasuda et al disclose that said updating means are formed by a serial wire link (21) (see Fig. 2, col. 3, lines 48-58).

Regarding to claim 5, (see Fig. 1,2 & 3 and col. 2, line 49 to col. 5 line 38), Yasuda disclose that a method comprises:

storing data in a first apparatus (1B) (see Fig. 3 and col. 3, line 58 to col. 4 line 7); and

taping update data from a second apparatus (1A) of the same type as the first apparatus to update the data in the first apparatus (see Fig. 3 and col. 3, line 58 to col. 4 line 7).

He does not disclose that the data, which is stored in RAM, is operating software.

However, Ellis et al disclose that the application software is stored in non-volatile memory such as ROM or static RAM (see col. 9, lines 16–21).

Therefore, at the time of the invention was made, it would have been obvious for one having skilled in the art to modify the data to the operating software, as taught by Ellis et al, so that the apparatus is capable to operate a new software.

Regarding to claim 6, Yasuda et al disclose that the method wherein taping update data from a second apparatus of the same type as the first apparatus to update data in the first apparatus includes:

Step (106,110) for preparation of a second apparatus (1A) for producing the update data (see Fig. 3, col. 4, lines 48-56),

Step (106,120) for preparation of a first apparatus (1B) for receiving the update (see Fig. 3, col. 4, line 48 to col. 5, line 10),

Step (120) for data transfer from the second apparatus to the first apparatus (see Fig. 3, col. 4, lines 48-60),

Step (121) for writing update data in the storage device of the first apparatus (see Fig. 3, col. 5, lines 31-38).

Regarding to claim 7, Yasuda et al disclose means (8, 11A, 11B, 21) for exchanging data wherein the first apparatus (1A) comprises means for communicating its data and the second apparatus (1B) comprises means updated with update data from the first apparatus (see Fig. 3, col. 4, line 48 to col. 5, line 50).

8. Claim 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al (5,062,132) *and Ellis as applied to claim 1 above, and further* in view of Kadaba et al (6,285,916).

Regarding to claim 3 (see Yasuda et al Fig. 1 &2), Yasuda et al does not disclose said updating means are formed by an infrared link. But, Yasuda et al

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disclose said updating means are formed by a transfer link as a cable link (21) for transferring data from 1A to 1B (see Fig. 2).

Kadaba et al discloses that data can alternatively be transferred by cable link or Infrared link (see Kadaba et al Fig. 1, col. 5, line 12 to 21)

At the time of the invention was made, It would have been obvious for a person skilled in the art to alternatively implement Yasuda et al's transfer link as an infrared link in order to transfer data wirelessly.

Regarding to claim 4 (see Yasuda et al Fig. 1 &2), Yasuda et al does not disclose said updating means are formed by a RF link. But, Yasuda et al disclose said updating means are formed by a transfer link as a cable link for transferring data from 1A to 1B (see Fig. 2).

Kadaba et al discloses that data can alternatively be transferred by cable link or RF link (see Kadaba et al Fig. 1, col. 5, line 12 to 21)

It would have been obvious for a person skilled in the art to alternatively implement Yasuda et al's invention to include RF link in order to transfer data wirelessly.

Response to Arguments

9. Applicant's arguments filed 06/08/2004 have been fully considered but they are not persuasive.

Objection to the specification under 35 USC 132:

Applicant, in his response, argues that the original specification and abstract do support the added limitation "operation software", because the original specification discloses on page 1 lines 1-22 that the document PCT WO 97/35453 updates or modifies the operation software. The examiner, however, disagrees. Since the original specification **does not incorporate the above document PCT WO 97/35453 by reference**, the above document is not a part of the original specification. See MPEP 2163.07(b). More important, the examiner does not find any portion in the specification, which clearly discloses that applicant's invention is directly "operation software". The portion pointed out in applicant's response is related to the PCT WO 97/35453, not to applicant's own invention.

Rejection to claims 1-7 under 35 USC 112. first paragraph:

As set forth above, the original specification **does not incorporate the above document PCT WO 97/35453 by reference**, the above document is not a part of the original specification and cannot be relied on to support the new added limitation "operating software" as recited in claims. See MPEP 2163.07(b). In addition, the examiner does not find any portion in the specification, which clearly discloses that applicant's invention is directly "operation software". The portion pointed out in applicant's response is related to the PCT WO 97/35453, not to applicant's own invention. Therefore, the rejection under 35 USC 112, 1st is proper.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703) 305-8635. The examiner can normally be reached on 8:00-16:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanh D. Phu
Examiner
Art Unit 2682

Sp


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PRIMARY EXAMINER